

Appl. No. 09/687,157
Amdt. dated March 22, 2004
Reply to Office Action of February 11, 2004

PATENT

REMARKS/ARGUMENTS

Amendments

The claims are modified in the amendment. More specifically, claim 9 has been amended. Therefore, claims 1-20 are present for examination. No new matter is added by these amendments. Applicants respectfully request reconsideration of this application as amended.

35 U.S.C. §112 Rejection

Claim 9 is rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter. Claim 9 is amended in the interests of furthering prosecution.

35 U.S.C. §102 Rejection, Grapes

The Office Action has rejected claims 1-3, 8 and 13-16 under 35 U.S.C. §102(e) as being anticipated by the cited portions of U.S. Patent No. 6,446,130 to Grapes (hereinafter "Grapes"). For a valid anticipation rejection, the Office personnel must show that each and every limitation from the claims appears in a single piece of prior art. Applicants believe major limitations from claims 1, 8 and 14 are neither taught nor suggested in the Grapes reference. More specifically, Grapes cannot be relied on to teach or suggest: (1) "receiving a command *from the content distributor* to store the program at the user location" as required by claims 1, 8 and 14 or (2) "sending the program to the user location for storage *before* a user requests the program" as required by claim 8. Emphasis added.

Grapes is drawn to a multimedia delivery system that provides programs to users according to user input or requests. This reference does not teach or suggest that programs are stored at the user location by commands received *from* the content distributor. Furthermore, this reference does not teach or suggest that the content distributor sends the program to the user location *before* the user requests such program. Grapes merely teaches storing being performed based upon input solely from the user.

Appl. No. 09/687,157
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Despite the position taken in the Office Action, Applicants believe the reference does not teach or suggest receiving commands *from* the content distributor to the user location, nor does it teach or suggest programs sent to user location *before* the user requests the programs. Reconsideration is respectfully requested for at least these reasons.

35 U.S.C. §103 Rejection, Grapes in view of Satterfield

The Office Action has rejected claims 4-6, 9, 12 and 17-19 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of U.S. Patent No. 6,446,130 to Grapes (hereinafter "Grapes") in view of the cited portions of U.S. Patent No. 6,305,017 to Satterfield (hereinafter "Satterfield"). Beyond the argument above relating to Grapes not teaching receiving commands from the content distributor, the cited portions of Satterfield also do not teach receiving commands from the content distributor.

Further, motivation for the specific combination of elements is lacking along with any reasonable likelihood of success in that combination. The motivation to combine arguments in the Office Action follow a reasoning that if someone made the combination and/or substitution, the advantages would be self-evident to one of ordinary skill in the art. That is not the proper reasoning as the art itself must suggest the specific combination and/or substitution. To first make the combination can only be done relying upon impermissible hindsight reconstruction guided by the claims.

Further, no cite is made to a reference for a motivation to combine so the Applicants can only assume Official Notice is being relied upon. Should this apparent Official Notice be maintained, Applicants respectfully traverse this Official Notice and hereby request an express showing of documentary proof of this proposition as set forth in MPEP 2144.03.

35 U.S.C. §103 Rejection, Grapes in view of Hall

The Office Action has also rejected claims 7, 11 and 20 under 35 U.S.C. §103(a) as being unpatentable over the cited portions of U.S. Patent No. 6,446,130 to Grapes (hereinafter "Grapes") in view of the cited portions of U.S. Patent No. 5,920,861 to Hall et al. (hereinafter

Appl. No. 09/687,157
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PATENT

"Hall"). Claims 7, 11 and 20 are allowable for at least the reasons that their respective parent claims are.

Further, motivation for the specific combination of elements is lacking along with any reasonable likelihood of success in that combination. With regard to the motivation to combine the references, no cite is made to a reference for a motivation to combine so the Applicants can only assume Official Notice is being relied upon. Should this apparent Official Notice be maintained, an express showing of proof is requested.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,

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